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TM

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/140,831 08/26/98 WELLS

G 9717-4

020575 PM82/1223
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EXAMINER

VANAMAN, F

ART UNIT

PAPER NUMBER

3611
DATE MAILED:

12/23/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/140,831

Applicant(s)

Wells

Examiner

Frank Vanaman

Group Art Unit

3611



☒ Responsive to communication(s) filed on Sep 28, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-12 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-7 is/are allowed.

☒ Claim(s) 8-12 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Information Disclosure Statement

1. The German reference (DT 26 18 723) previously cited by applicant but unavailable to the examiner has been considered, enclosed is a copy of the Form PTO-1449 originally submitted by applicant in the parent application with the notation that this reference has been considered.

Claim Rejections - 35 USC § 112

2. Claims 8-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 8, line 16, the term "strap pin" (2 occurrences) lacks a clear antecedent as noted in the previous office action. The examiner apologizes for failing to note the following instance of unclear claim language: in claim 10, line 16, the term "strap pin" lacks a clear antecedent basis.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. The indicated allowability of claims 8 and 9 is withdrawn in view of the newly discovered reference(s) to Douillet cited by applicant in the most recent Information Disclosure Statement (paper No. 7). Rejections based on the newly cited reference(s) follow.

5. Claims 8, 9, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douillet (EP 370,900, cited by applicant) in view of Wittstock (cited previously). Douillet teaches a ski pole grip (27) having a front, back and lateral sides, and an attachment system including a strap (43) having a pin (42, 44) with a notch (between 42, 44) connected to a glove (70), the

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skier's hand being (29) wrappable around the grip, and including a horizontal channel (33, 34) located above a substantial portion of the skier's hand for accommodating the pin, and a spring-biased (40) retractable finger (39) which protrudes across the channel and engage the notch in the pin, the finger actuable by a button (37) which may be depressed against the action of the spring while the skier's hand is wrapped around the grip, to release the pin. Note that tension in the strap associated with a drawing of the skier's hand away from the grip would inherently serve to remove the pin from the channel.

The reference of Douillet fails to teach the channel as being located entirely above a skier's hand. Wittstock teaches a ski-pole grip having a horizontal channel (18, 24) which engages a pin (30, 36) connected to a strap (22), wherein the channel location is taught to be above a skier's hand (note figure 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to locate the pin-engaging channel of Douillet to be entirely above a skier's hand for the purpose of insuring a complete disengagement of the pin from the channel even if a skier's hand is not entirely removed from the grip, for example in case of emergency conditions.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Douillet in view of Wittstock and Dondero (US 5,248,163, cited previously). The references of Douillet and Wittstock are discussed above and fail to teach the strap as being elastic. Dondero teaches a ski grip having a strap element (6) which is taught to be made of an elastic material. It would have been obvious to one of ordinary skill in the art at the time of the invention to make the strap of Douillet modified by Wittstock from an elastic material as taught by Dondero for the purpose of insuring the skier's hand is snugly coupled to the grip during skiing, even if the skier's grip relaxes, in order to prevent a skier from losing a grip on the gripping portion.

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Recapture

7. Claims 8-12 are rejected under 35 USC §251 as being an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. *See Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46, USPQ2d 1641 (Fed Cir. 1998); *In re Clement* 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 USC §251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The pending claims 8-12 fail to set forth the limitation of the pin-release button as being located on a lateral side of the ski pole grip, while patented claim 1 does include this limitation. Further note applicant's comments in paper No. 8 of the application for patent, particularly the first full paragraph of page 7, discussing the criticality of the lateral location of the pin release button, which same paper included an amendment which moved the limitation of the lateral positioning of the button from originally dependent claim 8 into the independent claim 1, canceling the original claim 1 which, while originally reciting a release button, failed to recite a lateral location of such a button.

Original Patent

8. Applicant is reminded that the original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

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Allowable Subject Matter

9. Claims 1-7 are allowed.

Response to Arguments

10. Applicant's comments directed to certain newly added claim limitations not shown by the Wittstock reference are noted and have been considered, but are moot in view of the newly cited reference to Douillet, as applied to claims 8-12. Note the withdrawal of Wittstock as a base reference.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Vanaman whose telephone number is (703) 308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, DC 20231

or faxed to :

(703) 305-3597 or 305-7687 (for formal communications intended for entry;
informal or draft communications may be faxed to the same number but should be
clearly labeled "UNOFFICIAL" or "DRAFT")

FRANK B. VANAMAN
Patent Examiner
Art Unit 3611

Frank Vanaman
December 20, 1999


12/20/99